UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SCOTT G. WALTON,
DARRIN LEONHARDT,
ROBERT A. MEGER,
RICHARD FERNSLER AND
CHRISTORPHER MURATORE

Appeal 2007-1470
Application 10/644,567
Technology Center 1700

Decided: September 25, 2007

Before BRADLEY T. GARRIS, CATHERINE Q. TIMM, and
LINDA M. GAUDETTE, *Administrative Patent Judges.*

GARRIS, *Administrative Patent Judge.*

ORDER REMANDING TO THE EXAMINER

We remand the above identified application to the Examiner for action consistent with our comments below.

The Appellants' Brief filed January 23, 2006 includes an Evidence Appendix which contains two pieces of evidence, namely, (1) a graph of

cross section vs. electron energy, and (2) an article entitled "Applications of Electron-Beam Generated Plasmas to Materials Processing." Moreover, the Brief contains arguments for nonobviousness which specifically refer to this evidence (Br. 3-4). However, the record of this application contains no indication that the Examiner has acknowledged the submission of this evidence and approved or disapproved the entry of the evidence. *See* the Answer mailed February 27, 2007 and the Advisory Action mailed September 7, 2005 (i.e., in response to Appellants' August 29, 2005 filing which first provided the afore-noted evidence). Likewise, the Answer contains no response by the Examiner to the arguments in the Brief concerning this evidence.

Under these circumstances, the Examiner must respond to this Remand by clarifying the application record as to whether this evidence is entered (and if not why not). Further, if the evidence is entered, the Examiner must respond to Appellants' arguments in the Brief concerning this evidence. Specifically, if the evidence and corresponding arguments do not persuade the Examiner that the § 103 rejections of record should be withdrawn, the Examiner must thoroughly explain why the evidence and arguments are considered to be inadequate to successfully rebut the § 103 rejections.

In addition, we observe that independent claim 1 contains language which may render the appealed claims in violation of the second paragraph of 35 U.S.C. § 112. The language in question reads "having a width <u>much</u> larger in dimension than its thickness" (claim 1; emphasis added). This language may offend the second paragraph of § 112 because the term

"much" is a word of degree and the Specification appears to provide no standard for measuring that degree. Thus, it is unclear whether one of ordinary skill in the art would understand what is being claimed even when claim 1 is read in light of the Specification. *See Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 574, 221 USPQ 568, 573-74 (Fed. Cir. 1984).

In response to this Remand, the Examiner must address and resolve on the written record whether and why the appealed claims do or do not satisfy the second paragraph requirements of 35 U.S.C. § 112.

Finally, appealed claim 1 recites three "means" and Appellants expressly acknowledge this fact albeit "[w]ithout admitting any applicability of 35 U.S.C. § 112, sixth paragraph" (Br. 2). Notwithstanding Appellants' desire to avoid admitting any sixth paragraph applicability, the Examiner must respond to this Remand by providing the written record of this application with an interpretation of the claim 1 "means" language in accordance with the guidelines set forth in the Manual of Patent Examining Procedure (MPEP) § 2181(8th ed., Rev. 5, Aug. 2006). As explained in these guidelines, such an interpretation is a necessary part of the examination process for determining compliance with the various requirements for patentability.

This Remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is **not** made (solely) for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) does not apply.

REMAND

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NAVAL RESEARCH LABORATORY
ASSOCIATE COUNSEL (PATENTS)
CODE 1008.2
4555 OVERLOOK AVENUE, S.W.
WASHINGTON, DC 20375-5320